

Appl. No. 10/785,538  
Amendment dated March 1, 2005  
Reply to Office Action mailed December 30, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 20 remain in this application. No claims have been cancelled or withdrawn. Claims 21 through 23 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 through 3 of the Office Action

Claims 1, 2, 8, and 9 have been rejected under 35 U.S.C. §102(e) as being anticipated by Corisis et al (US 2001/0012716A1).

Claims 7 and 10 through 11 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Corisis et al (US 2001/0012716A1).

The Corisis patent application, which is relied upon in each of the rejections of the Office Action, discusses two different embodiments of the "locking assembly" described in the application. One embodiment of the locking assembly is shown in Figures 1 and 3, and the other embodiment of the assembly is shown in Figures 2 and 4 of the Office Action. It is noted that much of the text of the rejection refers to Figure 4 of the Corisis application, which shows the second embodiment of the locking assembly that shows a "locking pin 26 which is fitted within printed circuit board 22 having resilient biasing portion 30, which fits and is received within opening 16 by N-hooks 32" (Corisis at paragraph [0022] of the published patent application).

However, it is submitted that the embodiment of Figures 2 and 4 of the Corisis application lack the "said first catch member having a first catch surface, said first catch surface generally lying in a plane forming a first catch member angle with respect to said reference plane of less than 90

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*degrees*" and "said second catch member having a second catch surface extending away from said second connector, said second catch surface generally lying in a plane forming a second catch member angle with respect to said reference plane of less than 90 degrees when said first connector of said add-on circuit card is in a mated condition with said second connector". Clearly, neither the "locking pin 26" of the locking assembly or the "opening 16" of Corisis shows or suggests the claimed catch surfaces or their claimed angular orientations, as the locking pin and the opening are shown in Figure 4. (The criticality of these claimed angular orientations is set forth at length in the present patent application at paragraph 22.)

In the event that the angles of the "J-hooks 20" of the embodiment of Figures 1 and 3 of the Corisis patent application are being relied upon as anticipating the angular orientation requirements of claim 1, it is noted that nothing in the Corisis patent application indicates that these distinct embodiments could be combined in any such manner, and it is submitted that one of ordinary skill in the art, considering the Corisis patent application, would not understand how these embodiments could be combined, particularly in a manner that would anticipate the claims invention. One of ordinary skill in the art is thus not provided with any suggestion to make any combination of these distinctly different embodiments.

Further, claim 1 requires "a second circuit card having a second connector for mating with said first connector to provide electrical contact between said add-on circuit card and said second circuit card". While the rejection of the Office Action identifies the element 22 of Corisis as being considered as the "second circuit card" of the requirements of claim 1, the text of the rejection does not appear to identify what element of the Corisis apparatus is being construed as being the "second connector" of claim 1. More significantly, claim 1 requires "a second catch member being located on said second connector and extending along said second connector". The

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rejection of the Office Action merely refers to "fig. 4" as showing this relationship, but again it is not clear what is being interpreted as anticipating the "second connector" and what is being interpreted as anticipating the "second catch member", other than these very broad references to Figure 4 of the Corisis published patent application.

In contrast to these requirements of claim 1, the Corisis published patent application shows a "locking pin 26" that is directly attached to the "substrate 22", and extends away from the substrate 22 without extending along anything that might be construed as a "second connector". In fact, the Corisis application implies that two separate locking pins 26 are employed (one at each end of the package 10), which indicates that no "catch member" extends along any "second connector", as required by claim 1.

With respect to the contention in the Office Action that, while Corisis "fails to explicitly disclose the exact size of the angles for the catch members",

[i]t would have an obvious matter of design choice to have the catch members at specific angles, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level skill of art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the catch members at specific angles in order to meet the system design and requirement in Corisis' device. . .

the Examiner's attention is again directed to paragraph 22 of the present patent application, where the particular advantages of the claimed angles of the invention are set forth and explained. The perpendicular orientation of the biasing portion 30 with respect to the remainder of the locking pin 26 and the package 10 does not provide these benefits, and would not lead one of ordinary skill in the art to the claimed invention.

It is therefore submitted that the Corisis published patent application would not lead one of ordinary skill in the art to the applicant's claimed

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invention as defined in claim 1, especially with the requirements set forth above, and therefore it is submitted that claim 1 is allowable over the prior art. Further, claims 2 through 11, which depend from claim 1, also include the requirements discussed above and therefore are also submitted to be in condition for allowance. Also, added claims 21 through 23 also depend from claim 1, and are also submitted to be in condition for allowance.

Withdrawal of the §102(e) and §103(a) rejections of claims 1 through 11 is therefore respectfully requested.

**Paragraph 4 of the Office Action**

Claims 12 through 20 have been allowed.

**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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